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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
TO, BAOTRAN N	

ART UNIT	PAPER NUMBER
2435	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/666,889	XUE, XIN	
	Examiner	Art Unit	
	Baotran N. To	2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is in response to the Amendment filed on 06/12/2009.

Claims 19, 28, and 36 are amended.

Claims 1-44 are presented for examination.

Response to Arguments

2. Applicant's arguments with respect to claims 19-23, 28-32, 36-40 have been considered but are moot in view of the new ground(s) of rejection.

Regarding Claims 1-8 and 44, Applicant appears to argue "the teachings of the prior art references are not sufficient to render the claim prima facie obvious" (Page 10 of Remarks).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Howard's reference and Hori's reference are analogous arts. They both specifically disclose how to download the content from the server that can support the motivation to combine the Howard's teaching within Hori's teaching to establish the limitations of Claim 1 that download the encrypted data from the content server (Hori, Abstract). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made

to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010).

Applicant further argues that "there is no indication in Hori that downloading the content to the removable memory instead of the user PC." It is not persuasive because the claimed limitation only requires "downloading the content from the server to the removable memory" recited in claim 1. Moreover, Hori explicitly discloses the claimed feature in paragraph 0065 "Memory card 110 receives the encrypted content data and license through cellular phone 100." It is clear that this citation reads on the claimed limitation.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., downloading the content to the removable memory **instead of the user PC**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that "it is unclear which elements of Hori are believed to be necessary to prevent distributed copyrighted data from being replicated without permission of the copyright owner" (page 10 of Remarks), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the

basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

For at least the above reasons, it is believed that the rejection is maintained.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 04/03/2009, 05/19/2009, and 07/10/2009. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1- 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. (U.S. Patent Application Publication: 2004/0103064 A1) hereinafter Howard in view of Hori et al. (U.S. Patent Application Publication: 2004/0010467 A1) hereinafter Hori.

Regarding Claims 1 and 10, Howard discloses a method of downloading content from a server to an electronic device (Figure 1, elements 10, 30, and 40), comprising:

storing authentication data on a removable memory (smart card 14) (paragraph 0020), wherein the authentication data includes a predetermined level of content access (paragraphs 0022-0026);

accessing the server with the electronic device (Figure 1, elements 10, paragraph 0021);

authenticating the removable memory by reading the authentication data from the removable memory (paragraph 0020) to determine the predetermined level of content access (paragraphs 0022-0026); and

downloading the content from the server to the PC (paragraph 0025) according to the predetermined level of content access (paragraphs 0022-0026), but fails to disclose downloading the content from the server to the removable memory.

However, Howard expressly discloses downloading the content from the server to the removable memory (Figure 6, paragraphs 0065 and 0171).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010).

Regarding Claim 19, Howard discloses a system for downloading content (Figure 1), comprising:

a removable memory (Figure 1, smart card 14), the removable memory including authentication data (paragraph 0020), wherein the authentication data includes a predetermined level of content access (paragraphs 0022-0026);

an electronic device (Figure 1, element 10) configured to receive the removable memory (paragraph 0018); and

a server (Figure 1, elements 30 and 40, paragraph 0022), wherein when the electronic device accesses the server (paragraph 0021), the removable memory is authenticated by reading the authentication data from the removable memory (paragraph 0020) and determining the predetermined level of content access (paragraphs 0022-0026), and further

wherein once authenticated (paragraph 0021), content according to the predetermined level of content access is downloaded from the server to the electronic device (Figure 1, elements 10 and 40, paragraphs 0022-0026), but fails to disclose downloading the content from the server to the removable memory.

However, Howard expressly discloses downloading the content from the server to the removable memory (Figure 6, paragraphs 0065 and 0171).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010).

Regarding Claim 28, Howard discloses an electronic device (Figure 1, element 10) for downloading (Abstract), comprising:

a memory slot (Figure 1, card reader 12) configured to receive a removable memory (Figure 1, smart card 14), wherein the removable memory includes authentication data (paragraph 0020), the authentication data includes a predetermined level of content access (paragraphs 0022-0026); and

a communications interface configured for coupling to a server (Figure 1, elements 30 and 40, paragraph 0022), wherein when the electronic device accesses the server through the communications interface (Figure 1, paragraphs 0018-0021), the removable memory is authenticated by reading the authentication data from the removable memory (paragraph 0020) to determine the predetermined level of content access (paragraphs 0022-0026),

further wherein content according to the predetermined level of content access is downloaded (Figure 1, elements 10 and 40, paragraphs 0022-0026), but fails to disclose downloading the content from the server to the removable memory.

However, Howard expressly discloses downloading the content from the server to the removable memory (Figure 6, paragraphs 0065 and 0171).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010).

Regarding Claim 36, Hori discloses a removable memory (memory card 110/112) for downloading, comprising:

authentication data (paragraph 0020), the authentication data includes a predetermined level of content access (paragraphs 0022-0026)

a communications interface configured for coupling to a server (Figure 1, elements 30 and 40, paragraph 0022), wherein when an electronic device (Figure 1, element 10) accesses the server through the communications interface (Figure 1, paragraphs 0018-0021), the removable memory is authenticated by reading the authentication data from the removable memory (paragraph 0020) to determine the predetermined level of content access (paragraphs 0022-0026), further wherein the electronic device includes a memory slot (Figure 1, card reader 12) configured to receive the removable memory (Figure 1, smart card 14, paragraph 0018), and further

wherein content according to the predetermined level of content access is downloaded (Figure 1, elements 10 and 40, paragraphs 0022-0026), further wherein the predetermined level of content access determines how much of the content on the server is available for download (paragraph 0025), but fails to disclose downloading the content from the server to the removable memory.

However, Howard expressly discloses downloading the content from the server to the removable memory (Figure 6, paragraphs 0065 and 0171).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have

been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010).

Regarding Claim 44, Howard discloses a method of downloading content from a server to an electronic device (Figure 1), comprising:

storing authentication data on a removable memory (smart card 14) (paragraph 0020), wherein the authentication data includes a predetermined level of content access (paragraphs 0022-0026);

accessing the server with the electronic device (Figure 1, elements 10, paragraph 0021);

authenticating the removable memory by reading the authentication data from the removable memory (paragraph 0020) to determine the predetermined level of content access (paragraphs 0022-0026);

wherein the authentication data is time stamped, such that the predetermined level of content access is available for a predetermined amount of time (paragraphs 0022-0026); and

downloading the content from the server to the PC (paragraph 0025) according to the predetermined level of content access (paragraphs 0022-0026), but fails to disclose downloading the content from the server to the removable memory.

However, Howard expressly discloses downloading the content from the server to the removable memory (Figure 6, paragraphs 0065 and 0171).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have

been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010).

Regarding Claims 2, 11, 20, 29, and 37, Howard and Hori disclose the limitations of Claim 1 above. Hori further discloses wherein the authenticating is performed by the server (Howard, paragraph 0022 and Hori paragraph 0063).

Regarding Claims 3, 12, 21, 30, and 38, Howard and Hori disclose the limitations of Claim 1 above. Hori further discloses wherein the removable memory is a semiconductor memory (Howard, Figure 1, element 14 and Hori Figure 1, element 110, paragraph 0065).

Regarding Claims 4, 13, 21, 31, and 39, Howard and Hori disclose the limitations of Claim 1 above. Howard further discloses time stamping the authentication data, such that the predetermined level of content access is available for a predetermined amount of time (paragraphs 0022-0026).

Regarding Claims 5, 14, 23, 32, and 40, Howard and Hori disclose the limitations of Claim 1 above. Howard and Hori further disclose wherein the server is accessed through a wired internet connection, further wherein the wired internet connection includes a conduit and a personal computer (Howard, Figure 1, paragraph 0018 and Hori Figures 1 and 4).

Regarding Claims 6, 15, 24, 33, and 41, Howard and Hori disclose the limitations of Claim 1 above. Hori further discloses wherein the server is accessed through a wireless connection (Figure 1, paragraph 0076).

Regarding Claims 7, 16, and 25, Howard and Hori disclose the limitations of Claim 6 above. Hori further discloses wherein the wireless connection includes an internet connection (paragraph 0071).

Regarding Claims 8, 17, 26, 34, and 42, Howard and Hori disclose the limitations of Claim 6 above. Hori further discloses wherein the wireless connection includes a local area network (paragraph 0071).

Regarding Claims 9, 18, 27, 35, and 43, Howard and Hori disclose the limitations of Claim 6 above. Hori further discloses wherein the wireless connection includes a wide area network (paragraph 0071).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baotran N. To whose telephone number is (571)272-8156. The examiner can normally be reached on Monday-Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. N. T./
Examiner, Art Unit 2435
/Kimyen Vu/
Supervisory Patent Examiner, Art Unit 2435